



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,560	07/27/2005	Toshiyuki Ai	4252-0113PUS1	2369
2292 7590 09/29/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER GRUN, ROBERT J				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
09/29/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

# Office Action Summary

**Application No.**

10/521,560

**Applicant(s)**

AI, TOSHIYUKI

**Examiner**

ROBERT J. GRUN

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date 01/19/2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Takashi (Patent Abstracts of Japan 07-063968).
  - Regarding Claim 1: Takashi teaches an alicyclic resin lens (11) (polycarbonate) being formed at the same as a synthetic resin frame (12) (abstract, Drawing 1, and [0012]), by injecting resin in a mold with a lens cavity and a frame cavity (double injection) to integrally form lens and frame.
3. Claims 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Takashi (Patent Abstracts of Japan 07-063968).
  - Regarding Claim 7: Takashi teaches a alicyclic lens (polycarbonate) being formed at the same as a synthetic resin frame (abstract and [0012]), by injecting resin in a mold with a lens cavity and a frame cavity (double injection) to integrally form lens and frame.
  - Regarding Claim 8: Takashi teaches the invention as described in the rejection of claim 7. Takashi further teaches a protrusion on the inner circumferential surface of the holding frame which secures the lens to the frame (Drawing 1, see protrusion near edge of lens).

- Regarding Claim 9: Takashi teaches the invention as described in the rejection of claim 7 and 8. Takashi further teaches the protrusion is an undercut protrusion (Drawing 1, see protrusion near edge of lens).
- Regarding Claim 10: Takashi teaches the invention as described in the rejection of claim 7 - 9. Takashi further teaches the protrusion peak shaped (Drawing 1, see protrusion near edge of lens).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takashi (Patent Abstracts of Japan 07-063968) as applied to claim 1 above.

- Regarding Claim 2: Mold shrinkage is dependent upon mold parameters used and is therefore a result effective variable. One of ordinary skill in the art at the time of invention would have found it obvious to vary the mold parameters in order to minimize mold shrinkage.
- Regarding Claim 3: While Takashi does not disclose the order of injection into the mold, one of ordinary skill in the art at the time of invention would have found order of injection to be a matter of routine experimentation well within the purview of those skilled in the art.

- Regarding Claim 4: While Takashi does not disclose the thermal deformation temperature of the holding frame resin material or lens resin material, one of ordinary skill in the art at the time of invention would have found it obvious to make the frame have a higher deformation temperature than that of the lens because the frame is in contact with the machinery and must withstand a higher temperature than that of the lens which is not in contact with the surrounding machinery.
- Regarding Claim 5: While Takashi does not disclose the use of pin-point gates in the injection molding apparatus, one of ordinary skill in the art at the time of invention would have found pin-point gates in the injection apparatus obvious because pin-point gates are common in the art of injection molding of parts with thin walls.
- Regarding Claim 6: While Takashi does not disclose the use of pin-point gates in the injection molding apparatus, one of ordinary skill in the art at the time of invention would have found using a tab ejector in the injection apparatus obvious because tab ejectors are common in the art of injection molding and are commonly used for delicate removal of thin walled parts from mold cavities.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT J. GRUN whose telephone number is (571)270-5521. The examiner can normally be reached on Monday-Thursday 07:30-17:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ROBERT J GRUN/  
Examiner, Art Unit 1791

/Philip C Tucker/  
Supervisory Patent Examiner, Art Unit 1791